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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/631,837	08/01/2003	Mike V. Naples	08049.0921	1034
22852	7590	03/10/2008		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER STERRETT, JONATHAN G	
			ART UNIT 3623	PAPER NUMBER
			MAIL DATE 03/10/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/631,837

Applicant(s)

NAPLES ET AL.

Examiner

JONATHAN G. STERRETT

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-90 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-90 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- Group I. **Claims 1-39 and 85**, drawn to **calculating ROI of a marketing campaign**, classified in class 705, subclass 35.
- Group II. **Claims 40-48 and 86**, drawn to **performing a financial sensitivity analysis**, classified in class 705, subclass 35.
- Group III. **Claims 49-69 and 87**, drawn to **comparing shipping services**, classified in class 705, subclass 7.
- Group IV. **Claims 70-75, 88 and 89**, drawn to **performing scenario analysis of a marketing campaign**, classified in class 705, subclass 7.
- Group V. **Claims 76-84 and 90**, drawn to **promoting a shipping service using finance and ROI information**, classified in 705 subclass 7.

The Inventions are distinct, each from the other because of the following reasons:

1. **Group I to II**

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a method of **calculating ROI of a marketing campaign** and can be conducted

without **performing a financial sensitivity analysis**. Further one does not need to **perform a financial sensitivity analysis** in order to **calculate an ROI of a marketing campaign**. The subcombination has a separate utility such as **performing a financial sensitivity analysis**. See MPEP § 806.05(d).

2. **Group I to III**

Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a method of **calculating ROI of a marketing campaign** and can be conducted without **comparing shipping services**. Further one does not need to **compare shipping services** in order to **calculate an ROI of a marketing campaign**. The subcombination has a separate utility such as **comparing shipping services**. See MPEP § 806.05(d).

3. **Group II to III**

Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as a method of **performing a financial sensitivity analysis** and can be conducted without **comparing shipping services**. Further one does not need to **compare shipping services** in order to **perform a financial sensitivity analysis**. The

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subcombination has a separate utility such as **comparing shipping services**. See MPEP § 806.05(d).

4. **Group I to IV**

Inventions I and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a method of **calculating ROI of a marketing campaign** and can be conducted without **performing scenario analysis of a marketing campaign**. Further one does not need to **perform scenario analysis of a marketing campaign** in order to **calculate an ROI of a marketing campaign**. The subcombination has a separate utility such as **performing scenario analysis of a marketing campaign**. See MPEP § 806.05(d).

5. **Group II to IV**

Inventions II and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as a method of **performing a financial sensitivity analysis** and can be conducted without **performing scenario analysis of a marketing campaign**. Further one does not need to **perform scenario analysis of a marketing campaign** in order to **perform a**

financial sensitivity analysis. The subcombination has a separate utility such as **performing scenario analysis of a marketing campaign**. See MPEP § 806.05(d).

6. **Group III to IV**

Inventions III and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as a method of **comparing shipping services** and can be conducted without **performing scenario analysis of a marketing campaign**. Further one does not need to **perform scenario analysis of a marketing campaign** in order to **compare shipping services**. The subcombination has a separate utility such as **performing scenario analysis of a marketing campaign**. See MPEP § 806.05(d).

7. **Group I to V**

Inventions I and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as a method of **calculating ROI of a marketing campaign** and can be conducted without **promoting a shipping service using finance and ROI information**. Further one does not need to **promote a shipping service using finance and ROI information** in order to **calculate an ROI of a marketing campaign**. The subcombination has a

separate utility such as **promoting a shipping service using finance and ROI information**. See MPEP § 806.05(d).

8. **Group II to V**

Inventions II and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as a method of **performing a financial sensitivity analysis** and can be conducted without **promoting a shipping service using finance and ROI information**. Further one does not need to **promote a shipping service using finance and ROI information** in order to **perform a financial sensitivity analysis**. The subcombination has a separate utility such as **promoting a shipping service using finance and ROI information**. See MPEP § 806.05(d).

9. **Group III to V**

Inventions III and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as a method of **comparing shipping services** and can be conducted without **promoting a shipping service using finance and ROI information**. Further one does not need to **promote a shipping service using finance and ROI information** in order to **compare**

shipping services. The subcombination has a separate utility such as **promoting a shipping service using finance and ROI information.** See MPEP § 806.05(d).

10. **Group IV to V**

Inventions IV and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as a method of **performing scenario analysis of a marketing campaign** and can be conducted without **promoting a shipping service using finance and ROI information.** Further one does not need to **promote a shipping service using finance and ROI information** in order to **perform scenario analysis of a marketing campaign.** The subcombination has a separate utility such as **promoting a shipping service using finance and ROI information.** See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for each of the Groups I, II and III is not required for each of the other groups (i.e., I, II), restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan G. Sterrett whose telephone number is 571-272-6881. The examiner can normally be reached on 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For

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more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JGS 2008220

/Jonathan G. Sterrett/

Primary Examiner, Art Unit 3623